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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,146	09/08/2003	Xavier Blin	05725.1239-00	1368
22852 7590 10/23/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER ROGERS, JAMES WILLIAM	
			ART UNIT 1618	PAPER NUMBER
			MAIL DATE 10/23/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/656,146	Applicant(s) BLIN ET AL.	
	Examiner James W. Rogers, Ph.D.	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-118 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-118 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection necessitated by amendment.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6,10-13,24-32,36-39,50-65,69-72,83-84,86-94,98-101 and 112-118 are rejected under 35 U.S.C. 102(b) as being anticipated by Arnaud et al. (US 5,961,998), this new rejection was necessitated by applicants amendments to the claims filed 09/13/2007.

Arnaud teaches glossy compositions, specifically make-up compositions intended for use on the skin and mucous membranes such as the lips. See abstract and col 1 lin 5-19. The composition contains 5 to 80% by weight of one or more oils with an aromatic group including PDM 1000 and PCR 15M30; as recited within applicants own specification (See [0045] of US 20040126350 A1) these two phenyl-siloxanes meet applicants claimed high viscosity phenylsiloxane. See col 3 lin 14-col 4 lin 44. The

Art Unit: 1618

compositions also contain an additional type of oil other than the aromatic containing oil including synthetic esters such as diisostearyl malate and triisocetyl citrate, these additional oils can represent 5 to 30% by weight of the composition. See col 5 lin 21-col 6 lin 6. Regarding the proviso that the composition contains no more than 5% of a volatile oil, the composition as recited within Arnaud only uses a non-volatile hydrocarbon solvent. Regarding the limitations that the composition has an average gloss and a post-trial staying power within a certain amount, since the composition of Arnaud comprises the same ingredients as applicants it inherently meets the above limitations because the same composition will have the same properties. It appears as though applicants are claiming a new or undiscovered property of an old composition. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Additionally the compositions can contain 5 to 30% of various ingredients including waxes that can be silicone based, microcrystalline or synthetic waxes such as polyethylene waxes and silicone waxes such as alkyl- or alkoxydimethicones having from 16 to 45 carbon atoms. See col 6 lin 30-46. The composition could further comprise 0.5-20% of a particulate phase that includes pigments and/or pearlescent agent and or fillers. See col 4 lin 45-col 5 lin 20. Regarding the limitation that the composition is anhydrous Arnaud clearly

states that water can be present in amounts of 0-95% although it is clearly optional and thus a composition free of water would be anhydrous. See col 6 lin 27-29.

Claims 1-7,10-33,36-52,54-66,69-84,86-95 and 98-118 are rejected under 35 U.S.C. 102(e) as being anticipated by Agostini et al. (US 2003/0017124 A1), this new rejection was necessitated by applicants amendments to the claims filed 09/13/2007.

The applied reference has a common Assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Agostini teaches a two-coat makeup product for the skin, lips or other integuments that contains two compositions. See abstract and [0003]. The second composition includes non-volatile liquids such as hydrocarbon based liquids including diisostearyl malate and high and low viscosity silicone oils that meets applicants claimed high and low viscosity phenylsiloxane. See[0152]-[0202] Regarding the proviso that the composition contains no more than 5% of a volatile oil, the second composition as recited within Agostini only uses a non-volatile solvent. Regarding the limitations that the composition has an average gloss and a post-trial staying power within a certain amount, since the composition of Agostini comprises the same ingredients as applicants it inherently meets the above limitations because the same composition will have the same properties. It appears as though applicants are claiming a new or undiscovered

Art Unit: 1618

property of an old composition. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). The nonvolatile liquid can comprise from 1% to 100%, preferably 5 to 95%, better still from 20 to 80% and better still 40 to 80% of the total composition. The ratio of the low-viscosity and high viscosity phenylsiloxane oil can range from 70/30 to 30/70, better still from 60/40 to 40/60 and better still from 55/45 to 45/55, within applicants claimed ratio. The second composition includes a coloring agent that may also be present in a particulate paste; advantageously the particulate paste is a pigmentary paste. See [0206]-[0242]. The amount of particulate matter within the composition can be from 0.5 to 60, preferably 2 to 40% and most preferably from 3 to 30% of the total composition. The second composition could additionally comprise from 0 to 20% by weight of additives including waxes that are hydrocarbon based, silicone based and/or fluoro based. See [0143] and [0243]-[0248]. Numerous different types of waxes could be selected and include microcrystalline wax, polyethylene wax, silicone waxes made from alkyl, alkoxy and/or esters of polymethylsiloxane, preferably the amount of wax present is from 3 to 25%. Regarding the limitation that the composition is anhydrous Agastoni specifically recites that the second composition is advantageously in anhydrous form. See [0255].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-118 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agostini et al. (US 2003/0017124 A1), this new rejection was necessitated by applicants amendments to the claims filed 09/13/2007.

Agostini is disclosed above. Agostini discloses all of applicants claimed ingredients such as the non-volatile oils, waxes and particulate matter such as pigments, the ranges of the above overlap applicants disclosed range although they are not encompassed totally within applicants disclosed range. However it would have been obvious to one skilled in the art that through routine optimizations of the ingredient amounts that one could make a composition with applicants claimed range. It is a prima facie case of obviousness typically exists when the ranges of a claimed composition overlap the ranges disclosed in the prior art. E.g., In re Geusler, 116 F.3d 1465, 1469, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997); In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (CCPA 1976); In re Malagari, 449 F.2d 1297, 1202, 182 USPQ 549, 553 (CCPA 1974). It is the normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages. See In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980) ("[D]iscovery of an optimum value of the result effective variable in a known process is ordinarily within the skill of the art." See, e.g., In re Baird, 16 F.3d 380, 29 USPQ2d 1550 (Fed. Cir. 1994); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). *In re Paterson Appeal* No. 02-1189 (Fed. Cir. January 8, 2003).

Claims 1-118 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnaud et al. (US 5,961,998), this new rejection was necessitated by applicants amendments to the claims filed 09/13/2007.

Arnaud is disclosed above. Arnaud in addition to describing high viscosity phenylsiloxanes also discloses the use of low viscosity phenyl siloxanes such as DC556. Therefore since Arnaud discloses that either a high viscosity or low viscosity phenylsiloxane can be used as the oil it would have been obvious to one skilled in the art to try a mixture of at least two of the phenylsiloxanes; since they were disclosed as being used for the same purpose and the addition would not change the respective functions of the oils. Arnaud discloses all of applicants claimed ingredients such as the non-volatile oils, waxes and particulate matter such as pigments, the ranges of the above overlap applicants disclosed range although they are not totally encompassed within applicants disclosed range. However it would have been obvious to one skilled in the art that through routine optimizations of the ingredient amounts that one could make a composition with applicants claimed range. It is a prima facie case of obviousness typically exists when the ranges of a claimed composition overlap the ranges disclosed in the prior art. E.g., In re Geusler, 116 F.3d 1465, 1469, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997); In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (CCPA 1976); In re Malagari, 449 F.2d 1297, 1202, 182 USPQ 549, 553 (CCPA 1974). It is the normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages. See In re Boesch, 617 F.2d 272, 276, 205

USPQ 215, 219 (CCPA 1980) (“[D]iscovery of an optimum value of the result effective variable in a known process is ordinarily within the skill of the art.” See, e.g., In re Baird, 16 F.3d 380, 29 USPQ2d 1550 (Fed. Cir. 1994); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). *In re Paterson* Appeal No. 02-1189 (Fed. Cir. January 8, 2003).

Claims 1-118 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnaud et al. (US 5,961,998) in view of Willemin et al. (US 6,592,855 B1, cited in previous office action), this new rejection was necessitated by applicants amendments to the claims filed 09/13/2007.

Arnaud is disclosed above. Arnaud while disclosing both the use of low and high viscosity phenylsiloxanes is silent on the use of a low and high viscosity phenylsiloxanes in combination.

Willemin was cited in the previous office action filed 06/14/2007. Willemin is used primarily for the disclosure within that low viscosity phenylsiloxanes were well known in the art to be useful in cosmetic formulations.

It would have been prime facie obvious at the time of the invention to a person of ordinary skill in the art to modify the cosmetic formulation disclosed in Arnaud and add the low viscosity phenylsiloxanes disclosed within Willemin. It is generally considered to be prime facie obvious to combine compounds each of which is taught by the prior art to be useful for the same purpose in order to form a composition that is to be used for an identical purpose. The motivation for combining them flows from their having been used individually in the prior art, and from them being recognized in the prior art as useful for the same purpose. As shown by the recited teachings, instant claims are no more than

the combination of conventional components found within a cosmetic formulation. It therefore follows that the instant claims define prime facie obvious subject matter.

Conclusion

No claims are allowed at this time.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers, Ph.D. whose telephone number is (571) 272-7838. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 271-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent

Art Unit: 1618

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MICHAEL G. HARTLEY
SUPERVISORY PATENT EXAMINER